

Application No.: 09/886,400

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REMARKS**Status of the Claims***Pending claims*

Claims 93 to 95, 99 to 132 and 138 to 152 are pending.

Allowed claims

Applicants thank the Examiner for finding that claims 104, 132, 151, 152 appear to be allowable over the prior art of record, and that claims 95, 103, 121 and 128 appear to be allowable over the prior art of record but are objected to since they depend upon rejected base claims.

Claims canceled in the instant amendment

In the present response, claims 93, 94, 99 to 102, 105 to 117, 125 to 127, 129 to 131, and 138 to 150, are canceled, without prejudice or disclaimer. Accordingly, after entry of the instant amendment, claims 95, 103, 104, 118 to 121, 128, 132, 151 and 152 will be pending and under examination.

Applicants respectfully request entry of the amendments set forth in this response under 37 CFR §1.116. The amendment places the case in condition for allowance and places the case in better condition for appeal; the amendment does not raise any issues of new matter; and, the amended claims do not present new issues requiring further consideration or search.

Allowable pending claims were amended to incorporate limitations of their base claims and/or to be dependent on allowable claims.

Outstanding Rejections

Claims 149 and 150 are rejected under 35 U.S.C. §112, second paragraph. The rejection of claims 105 to 131 was maintained and new claims 138 to 149 are rejected under 35 U.S.C. §112, first paragraph, written description requirement. The rejection of claims 93, 94, 99 to 102, 105 to 120, 125 to 127 and 129 to 131 was maintained and new claims 138 to 149 are rejected under 35

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U.S.C. §112, first paragraph, enablement requirement. Applicants respectfully traverse all outstanding objections to the specification and rejection of the claims.

Issues under 35 U.S.C. §112, first paragraph

Written Description

The rejection of claims 105 to 131 was maintained and new claims 138 to 149 are rejected under 35 U.S.C. §112, first paragraph, written description requirement, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors at the time the application was filed had possession of the claimed invention.

Applicants respectfully maintain that the claimed invention is sufficiently described in the specification so that one of ordinary skill in the art would be able to ascertain the scope of the claims with reasonable clarity and recognize that Applicants' were in possession of the claimed invention at the time of filing. Applicants respectfully submit that the pending claims meet the written description requirement under 35 U.S.C. §112, first paragraph, for reasons set forth in Applicants previous responses, which are expressly incorporated herein.

However, merely to expedite prosecution and allowance of this application, claims 93, 94, 99 to 102, 105 to 117, 125 to 127, 129 to 131, and 138 to 150, are canceled, without prejudice or disclaimer. Allowable pending claims were amended to incorporate limitations of their base claims and/or to be dependent on allowable claims.

In light of the above remarks, Applicants respectfully submit that the amended claims are sufficiently described in the specification to overcome the 35 U.S.C. §112, first paragraph, written description rejection.

Enablement

The rejection of claims 93, 94, 99 to 102, 105 to 120, 125 to 127 and 129 to 131 was maintained and new claims 138 to 149 are rejected under 35 U.S.C. §112, first paragraph,

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enablement requirement, as allegedly not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention.

Applicants respectfully maintain that the specification enabled the skilled artisan at the time of the invention to identify, and make and use, a genus of alpha galactosidases to practice the claimed invention. Applicants respectfully submit that the pending claims meet the enablement requirement under 35 U.S.C. §112, first paragraph, for reasons set forth in Applicants previous responses, which are expressly incorporated herein.

However, merely to expedite prosecution and allowance of this application, claims 93, 94, 99 to 102, 105 to 117, 125 to 127, 129 to 131, and 138 to 150, are canceled, without prejudice or disclaimer. Allowable pending claims were amended to incorporate limitations of their base claims and/or to be dependent on allowable claims.

Applicants respectfully submit that the pending claims meet the enablement requirement under 35 U.S.C. §112, first paragraph. In light of the above remarks, Applicants respectfully submit that the specification sufficiently described how to make and use the claimed methods to satisfy the requirements of 35 U.S.C. §112, first paragraph.

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CONCLUSION

In view of the foregoing amendment and remarks, it is believed that the Examiner can properly withdraw the rejection of the pending claims under 35 U.S.C. §112, first and second paragraphs. Applicants believe all claims pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 564462000320. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

If the Examiner believes a telephone conference would expedite prosecution of this application, please call the undersigned at 858 720 5133.

Dated: January 5, 2005

Respectfully submitted,

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